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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/796,029 11/22/91 VALENTINIC

T 6451/043

EXAMINER

PEABODY, J

ART UNIT

PAPER NUMBER

WILLIAM DAVID KIESEL
P. O. BOX 15923
BATON ROUGE, LA 70895

1206
DATE MAILED:

#4
02/21/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☐ Responsive to communication filed on _____. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-7 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-7 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

Serial No. 07/796029

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Art Unit 1206

In the title the term "inctalurid" appears to be spelled. Appropriate correction is required.

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Jepson format of claim 1 is improper. See MPEP 608.01(m). In the instant case a description of "lure" and "bait" known in the prior art must be recited in order to be in proper Jepson format. (see 37 CFR 1.75(e)). Ex parte Jepson, 243 OG 525.

In claim 1, it is also not clear what is meant by the phrase "one or more of the free amino acids: L-alanine, L-arginine... etc." and represents improper Markush language. Language acceptable to the PTO would be "one or more of the free amino acids selected from the group consisting of L-alanine, L-arginine... etc." See MPEP 706.03(y).

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which

the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-7 are rejected under 35 U.S.C. § 103 as being unpatentable over Caprio (I, II and III). Caprio (I, II, and III) teaches amino acid compositions (i.e. that contain L-alanine, L-arginine or L-proline) in the amounts that release the snapping and biting response in fish. The claims appear to differ (if at all) in that functional language is used to describe the claimed composition of matter (i.e. "lure" and "bait"). It is pointed out that no patentable weight is given to the meaning of the said functional language in the preamble of claim 1. Applicant is not claiming a method of using said composition. Applicants claimed composition of matter would be obvious to one of ordinary skill in the art in view of the known compositions of matter disclosed by Caprio (I, II and III). Even though the prior art of Caprio (I, II and III) may not teach the use of the disclosed amino acid composition of matter as a "lure" or "bait" for fish, nonetheless the composition of matter itself is considered at least obvious in view of the said prior art.

Serial No. 07/796029

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Art Unit 1206

The reference not relied upon by the examiner is cited to further show the state of the art.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Peabody III, Ph.D. whose telephone number is (703) 308-4690.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

J.D.P. III

J.D.P. III
February 20, 1992

Marianne
MARIANNE CINTINS
PRIMARY EXAMINER
ART UNIT 132
1206